

ESTTA Tracking number: **ESTTA601379**

Filing date: **04/30/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	P.C. Richard & Son Long Island Corporation
Granted to Date of previous extension	04/30/2014
Address	150 Price Parkway Farmingdale, NY 11735 UNITED STATES
Attorney information	Celeste Butera Hoffmann & Baron 6900 Jericho Tpke Syosset, NY 11791 UNITED STATES cbutera@hbiplaw.com, cmbdocket@hbiplaw.com Phone: 516-822-3550

### Applicant Information

Application No	86031624	Publication date	12/31/2013
Opposition Filing Date	04/30/2014	Opposition Period Ends	04/30/2014
Applicant	JemRock Organization LLC 992 East Seventh Street Brooklyn, NY 11230 UNITED STATES		

### Goods/Services Affected by Opposition

Class 036. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Accounts receivables financing; Banking and financing services; Brokerage services for capital investments; Business brokerage; Business brokerage services and related consulting pertaining to procurement, buying, selling and tendering information and opportunities; Business finance procurement services; Capital investment services; Cash advance services for businesses and merchants; Cash flow services, namely, providing cash to mortgage holders or other notes at a discounted rate in return for ownership of the mortgage or note; Commercial lending services; Consumer lending services; Credit and loan services; Equity capital investment; Financial services, namely, money lending; Financial services, namely, raising debt and equity capital for others; Financially-guaranteed financing; Financing and loan services; Financing of industrial activities; Financing of loans; Financing of purchases; Financing of real estate development projects; Financing relating to automobiles; Financing services; Loan financing; Mortgage lending; Mortgage procurement for others; Private equity fund investment services; Project financing; Providing personal loans and lines of credit; Providing temporary loans; Providing venture capital, development capital, private equity and investment funding; Providing working capital; Providing working capital financing to small businesses and small business owners; Real estate financing services; Real estate lending services; Temporary loans; Venture capital financing; Venture capital funding services to emerging and start-up companies; Venture capital services, namely,

providing financing to emerging and start-up companies; Wholesale lending services

## Applicant Information

Application No	86031676	Publication date	12/31/2013
Opposition Filing Date	04/30/2014	Opposition Period Ends	
Applicant	JemRock Organization LLC 992 East Seventh Street Brooklyn, NY 11230 UNITED STATES		

## Goods/Services Affected by Opposition

Class 036. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Accounts receivables financing; Arranging of loans; Banking and financing services; Brokerage services for capital investments; Business brokerage; Business brokerage services and related consulting pertaining to procurement, buying, selling and tendering information and opportunities; Business finance procurement services; Capital investment services; Cashadvance services for businesses and merchants; Cash flow services, namely, providing cash to mortgage holders or other notes at a discounted rate in return for ownership of the mortgage or note; Commercial lending services; Consumer lending services; Credit and loan services; Equity capital investment; Financial investment brokerage; Financial investment brokerage services; Financial services, namely, assisting others with the completion of financial transactions for stocks, bonds, securities and equities; Financial services, namely, business fundraising for others; Financial services, namely, business fundraising provided over a computer network such as the Internet; Financial services, namely, investment advice, investment management, investment consultation and investment of funds for others, including private and public equity and debt investment services; Financial services, namely, money lending; Financial services, namely, raising debt and equity capital for others; Financially-guaranteed financing; Financing and loan services; Financing of industrial activities; Financing of loans; Financing of purchases; Financing of real estate development projects; Financing relating to automobiles; Financing services; Loan financing; Mortgage lending; Mortgage procurement for others; Private equity fund investment services; Project financing; Providing personal loans and lines of credit; Providing temporary loans; Providing venture capital, development capital, private equity and investment funding; Providing working capital; Providing working capital financing to small businesses and small business owners; Real estate financing services; Real estate lending services; Temporary loans; Venture capital financing; Venture capital funding services to emerging and start-up companies; Venture capital services, namely, providing financing to emerging and start-up companies; Wholesale lending services

## Applicant Information

Application No	86031695	Publication date	12/31/2013
Opposition Filing Date	04/30/2014	Opposition Period Ends	
Applicant	JemRock Organization LLC 992 East Seventh Street Brooklyn, NY 11230 UNITED STATES		

## Goods/Services Affected by Opposition

Class 036. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Accounts receivables financing; Arranging of loans; Banking and financing services; Brokerage of shares and other securities; Brokerage of shares or stocks and other securities; Brokerage services for capital investments; Brokerage services for stocks and bonds; Business brokerage; Business brokerage services and related consulting pertaining to business sales, mergers, acquisitions and business valuations; Business brokerage ser-

vices and related consulting pertaining to procurement, buying, selling and tendering information and opportunities; Business finance procurement services; Capital investment consulting; Capital investment services; Cash advance services for businesses and merchants; Cash flow services, namely, providing cash to mortgage holders or other notes at a discounted rate in return for ownership of the mortgage or note; Commercial lending services; Consultancy of capital investment; Consumer lending services; Credit and financial consultation; Credit and loan services; Credit consultation; Equity capital investment; Financial advice and consultancy services; Financial advisory and consultancy services; Financial analysis and consultation; Financial and investment services, namely, asset and investment acquisition, consultation, advisory and development; Financial and investment services, namely, management and brokerage in the fields of stocks, bonds, options, commodities, futures and other securities, and the investment of funds of others; Financial consultancy; Financial consultation; Financial consulting; Financial investment brokerage; Financial investment brokerage services; Financial loan consultation; Financial planning consultation; Financial research and equity research brokerage services; Financial services, namely, assisting others with the completion of financial transactions for stocks, bonds, securities and equities; Financial services, namely, business fundraising for others; Financial services, namely, business fundraising provided over a computer network such as the Internet; Financial services, namely, investment advice, investment management, investment consultation and investment of funds for others, including private and public equity and debt investment services; Financial services, namely, money lending; Financial services, namely, raising debt and equity capital for others; Financial services, namely, real estate note brokerage; Financially-guaranteed financing; Financing and loan services; Financing of industrial activities; Financing of loans; Financing of purchases; Financing of real estate development projects; Financing relating to automobiles; Financing services; Fund investment consultation; Investment consultancy; Investment consultation; Lending consultant services; Loan financing; Mortgage lending; Mortgage procurement for others; Private equity consultant services; Private equity fund investment services; Project financing; Providing personal loans and lines of credit; Providing temporary loans; Providing venture capital, development capital, private equity and investment funding; Providing working capital; Providing working capital financing to small businesses and small business owners; Real estate financing services; Real estate lending services; Temporary loans; Venture capital financing; Venture capital funding services to emerging and start-up companies; Venture capital services, namely, providing financing to emerging and start-up companies; Wholesale lending services

## Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1395362	Application Date	10/07/1985
Registration Date	05/27/1986	Foreign Priority Date	NONE
Word Mark	NOBODY BEATS THE WIZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1983/05/00 First Use In Commerce: 1983/05/00 RETAIL STORE SERVICES FOR AUDIO AND VISUAL EQUIPMENT AND ACCESSORIES, ELECTRICAL APPLIANCES, AND RECORDS AND TAPES		

U.S. Registration No.	1905190	Application Date	12/24/1992
Registration Date	07/11/1995	Foreign Priority Date	NONE

Word Mark	NOBODY BEATS THE WIZ
Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1983/05/00 First Use In Commerce: 1983/05/00 retail store services in the fields of audio and video equipment and accessories, computers and computer equipment and accessories, office equipment and accessories, computer software, photographic equipment, and household appliances

U.S. Registration No.	1204051	Application Date	05/22/1980
Registration Date	08/03/1982	Foreign Priority Date	NONE
Word Mark	THE WIZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1976/03/00 First Use In Commerce: 1976/03/00 Retail Store Services for Audio and Visual Equipment		

U.S. Registration No.	1893461	Application Date	11/05/1992
Registration Date	05/09/1995	Foreign Priority Date	NONE
Word Mark	THE WIZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1976/03/00 First Use In Commerce: 1976/03/00 retail store services in fields of consumer electronics and accessories, computer hardware and software, pre-recorded movies and music and household appliances		

Attachments	Notice_of_Opposition_NOBODY_BEATS_THE_WIZ_ET_AL.PDF(16899 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Celeste Butera/
Name	Celeste Butera
Date	04/30/2014

In the matter of Application Serial Nos. 86031624, 86031676, 86031695: NOBODY BEATS THE WIZ; THE WIZ; WIZ

Applicant.

1. P.C. Richard is a national retailer of electronics and appliances and provides financing of same in various forms.
2. P.C. Richard is the owner of the following registered and well-established Marks: NOBODY BEATS THE WIZ, Registration Nos.: 1395362 and 1905190; and THE WIZ, Registration Nos.: 1204051 and 1893461.

3. The registered trademarks have been continually and extensively used in commerce by P.C. Richard and P.C. Richard's first use date pre-dates Applicant's intent to use filing dates by many years.

4. P.C. Richard has offered and advertised and sold many millions of dollars' worth of goods and financing arrangements in connection with its registered marks set forth in Paragraph 2.

5. By virtue of the quality of Opposer's goods and services, and the extensive use and advertising of the registered trademarks in Paragraph 2, P.C. Richard has built up and now owns an extremely valuable goodwill which is symbolized by its registered Marks, and P.C. Richard's registered Marks have become famous prior to Applicant's use of the applied for marks and/or prior to the filing dates of Applicant's applications.

6. Applicant's proposed use of WIZ, THE WIZ, and NOBODY BEATS THE WIZ is without Opposer's consent or authorization.

7. The applied for marks are identical to Opposer's registered trademarks, and the services for which Applicant's mark is intended to be used are related to Opposer's goods and services.

8. Registration by Applicant of the applied-for marks would be damaging to Opposer and is likely to cause confusion, mistake, deception, and dilution as outlined below.

9. Registration and use by Applicant of its proposed marks will cause dilution of the distinctive qualities of Opposer's registered trademarks. Such dilution will likely cause irreparable harm and injury to the widespread reputation and good will developed as a result of Opposer's substantial efforts.

**COUNT I – LIKELIHOOD OF CONFUSION UNDER 15 U.S.C. §1052(d)**

10. Opposer realleges the allegations in Paragraphs 1 through 9.

11. Applicant's use and/or intended use of the marks for the services set forth its Application Serial Nos. 86031624, 86031676, 86031695 is likely to result in confusion, mistake, and/or deception in that consumers are likely to believe Applicant's services are Opposer's services, or the services of a person or company that is sponsored, authorized or licensed by, or in some other way legitimately connected with, Opposer.

**COUNT II – SUGGESTION OF A FALSE CONNECTION UNDER 15 U.S.C. § 1052(a)**

12. Opposer realleges the allegations in Paragraphs 1 through 11.

13. Since prior to the filing date of the opposed applications and by virtue of Opposer's registration, use, advertising, and promotion of its registered trademarks in connection with the sale, advertising, and marketing of Opposer's various products and services, the Opposer's registered marks have become well-known and closely identified with Opposer by consumers.

14. Applicant's applied for marks will be understood by consumers to refer to Opposer, and consumers will erroneously believe that Applicant's marks and the services provided thereunder, are associated with or authorized by, Opposer.

15. Opposer is not connected with Applicant's services, nor has Opposer authorized Applicant's use of the marks in connection with such services.

16. Opposer's registered marks are sufficiently well-known and closely identified with Opposer such that Applicant's use and registration of the marks for the applied for services will falsely suggest to consumers a connection with Opposer all in violation of 15 U.S.C. §1052(a).

### **COUNT III. DILUTION**

17. Opposer realleges the allegations in Paragraphs 1 through 16.

18. Pursuant to 15 U.S.C. §1063, registration of the marks in Applicant's serial nos. 86031624, 86031676, and 86031695 will damage Opposer because such registration is likely to cause dilution by blurring and/or tarnishment of Opposer's registered marks in Paragraph 2 in violation of 15 U.S.C. §1125(c).

**WHEREFORE**, Opposer respectfully requests that this opposition be sustained and that Application Serial Nos. 86031624, 86031676, 86031695 be denied registration.

Please address all correspondence to Celeste Butera, Hoffmann & Baron, LLP, 6900 Jericho Turnpike, Syosset, New York 11791.

Please charge the filing fees to the credit card provided.

Dated: April 30, 2014

Respectfully submitted,

/s/ Celeste M. Butera  
Celeste M. Butera

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*Attorneys for Applicant*  
*P.C. Richard & Son Long Island Corporation*



**CERTIFICATE OF SERVICE**

I, Celeste M. Butera, hereby certify that a copy of the **NOTICE OF OPPOSITION** has been served upon:

Jonathan Neuman, Esq.  
17625 Union Turnpike, Suite 230  
Fresh Meadows, New York 11366-1515

via first class mail, postage prepaid, this 30<sup>th</sup> day of April, 2014, and via e-mail to:  
[Jnesq@Jenesqlaw.com](mailto:Jnesq@Jenesqlaw.com).

/s/ Celeste M. Butera  
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Celeste M. Butera

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